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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,771	08/08/2006	Roland Wursche	291705US0PCT	4669

22850 7590 11/17/2008  
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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DOLLINGER, MICHAEL M

ART UNIT	PAPER NUMBER
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1796

NOTIFICATION DATE	DELIVERY MODE
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11/17/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/588,771	<b>Applicant(s)</b> WURSCHE ET AL.	
	<b>Examiner</b> MICHAEL DOLLINGER	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/08/2006</u> .  | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101 and 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-3 provides for the use of a molding compound, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-5 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

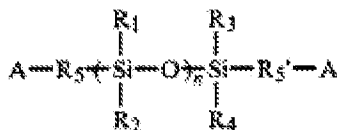
6. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mercx et al (EP 1 298 172 A1) in view of Ward et al (US 4,663,413).

7. Mercx et al disclose a metallized molded article composition which comprises a crystallizable polyester resin and a polymeric release agent/lubricant [abstract]. The metallized molded article is useful for automotive headlamp housings and reflectors [0001]. The Polyester resin is preferably a poly(alkylene terephthalate), most preferably poly(butylene terephthalate) [0008], and may also be poly(ethylene terephthalate), poly(propylene terephthalate), poly(ethylene naphthanoate) and poly(butylene naphthanoate) [0014] and is present in an amount of 70 to 99.9 weight percent [0007]. The polymeric release agent/lubricant is present in amount of 0.1 to 10% by weight more preferably 0.5 to 2 percent by weight [0009]. The compositions may further include nucleating agents, fillers and antioxidants [0010] up to 20 weight percent [0011].

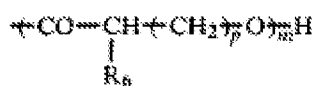
8. Mercx et al do not disclose the polysiloxane-polylactone block copolymer included in the metallized molded compositions as claimed in claims 1 and 2. Mercx et al do teach, however, that crystalline and crystallizable polyesters are preferred for the polyester component [abstract; 0007; 0008; 0013; 0019] and that nucleating agents (which promote crystallization) will improve heat resistance and hence increase cycle times to reduce production cost or improve color stability [0010].

9. Ward et al disclose polysiloxane-polylactone copolymers of the following formula:

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wherein n is an integer from 1 to about 200; R<sub>1</sub>, R<sub>2</sub>, R<sub>3</sub> and R<sub>4</sub> are independently, *inter alia*, linear or branched alkyl of 1 to 6 carbon atoms; A and A' are independently



wherein p is an integer from 0 to 6; m is an integer from 1 to about 250; R<sub>6</sub> is hydrogen or a linear or branched alkyl of 1 to 6 carbon atoms; R<sub>5'</sub> is, *inter alia*, -R<sub>7</sub>-O- and -R<sub>7</sub>-O- and R<sub>5</sub> is, *inter alia*, -R<sub>7</sub>-O-, -R<sub>7</sub>-O-, and -(CH<sub>2</sub>)<sub>t</sub>-(O-(CH<sub>2</sub>)<sub>r</sub>-O)<sub>v</sub>-(CH<sub>2</sub>)<sub>w</sub>-, wherein R<sub>7</sub> is - (CH<sub>2</sub>)<sub>q</sub>-, q is an integer from 1 to 20, r, t and w are integers from 1 to 6 and v is an integer from 1 to 100 [column 2 line 54 through column 3 lines 44]. Ward et al teach that the polysiloxane-poly lactone copolymers are useful as mold releasing agents and nucleating agents [column 2 lines 48-50]. Ward et al also teach that the polysiloxane-poly lactone block copolymers increase the crystallization rates of polyethylene terephthalate [column 2 lines 37-40].

10. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have added a polysiloxane-poly lactone copolymer to a metallized polyester molding composition because Mercx et al teach that it is within the skill of the art to metallize a polyester molding composition with a polymeric mold release agent and Ward et al teach that it is within the skill of the art to use a polysiloxane-poly lactone block copolymer as a mold releasing agent in a polyester

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molding composition. One would have been motivated to use the polysiloxane-poly lactone copolymer as the mold release agent because Ward et al teach that the polysiloxane-poly lactone block copolymers increase the crystallization rates or polyethylene terephthalate and Mercx et al teach that crystalline polyesters are preferable for the metallized molding compositions. Absent any evidence to the contrary, there would have been a reasonable expectation of success in using a polysiloxane-poly lactone block copolymer as a mold release agent and nucleating agent in a metallized polyester molding composition.

#### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL DOLLINGER whose telephone number is (571)270-5464. The examiner can normally be reached on Monday - Thursday 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Randy Gulakowski/  
Supervisory Patent Examiner, Art Unit 1796

MICHAEL DOLLINGER  
Examiner  
Art Unit 1796

/mmd/